

## DISCUSSION

First, it is noted that the Examiner has not provided any cite to a reference that obviates the SEQUENCE OF STEPS in the presently Pending Independent Claims as applied to periodically updated audio format continuing professional education in topical categories made available by the producer thereof via a website provided thereby, which updates the information provider represents to clients will be continued a multiplicity of times. Instead said sequence of steps is just assumed and arguments are made as to how cited materials somehow obviate elements therein. Even under an unreasonable reading of KSR, which did not speak to Method Claims as the Claim on point therein was a System/Apparatus Claim, this is not allowable under what KSR states is the still good law under Graham v. John Deere Co., (see below herein). Without use of prohibited hindsight obtained from using the present Application as a teaching reference, the Examiner has no basis for identifying the just assumed to exist SEQUENCE OF STEPS which were copied directly into his Action from my submittal without explanation as to how the SEQUENCE OF STEPS was provided or remotely suggested by any prior art!

Continuing, generally, it is noted that the newly cited Audible.com materials are much like what was disclosed by the now moot Darago et al. Patent, in that said references mostly describe systems for transmitting materials produced by others, rather than teaching production and provision of a continuing multiplicity of updated professional continuing education audio materials in specific categories to clients, under an agreement therewith to do so for payment from said Clients, as the presently Pending Claims recite. While there is mention in some

of the newly cited materials of production of programming materials by a transmitting company, the programming described is remote from programming as described in the present invention, or at best is prepared to train said client to overcome a specific documented professional competency deficiency or to provide basic education, such as demonstrated by passing exams after accessing said programming, which programming is specifically excluded by the present Claims. It is also noted that Novelty in Method Claims derives from a Sequence of Steps as well as the content of each step. Simply identifying a reference that discloses content which is somehow, in a modified form, similar to content in a Method Claim Step does not remotely serve to Obviate the Claim. In that light it is stressed that one skilled in the art would not remotely write the presently Pending Claims having studied the newly cited materials, if asked to describe what said newly cited materials disclose. This is because said newly cited materials, (even in combination with previously cited materials), simply do not disclose the presently Claimed invention sequence of steps. They miss that completely, and in addition, provide untoward disclosure not included in the present invention that teaches away therefrom, without providing any insight as to why such untoward disclosure should be ignored and why other information disclosed should be selected, modified and utilized!

As regards rejection of Claims 1, 6, 7, 9-12, 14, 19 and 21-27, it is not understood to what Lawcast (Paper #20070102, PTO-892, Item "V", Pages 1-2), refers. What I find is that item "V" in the present Action is a reference regarding Audible.com? Am I missing a reference? I find no new Lawcast materials accompanying the present Action hence assume the Lawcast reference is to the materials presented in prior Actions? which materials teach away from using the internet to distribute audio

updates. As established in a prior Response, said previously presented Lawcast materials teach away from distribution of the described programming over the internet, therefore one skilled in the art having knowledge thereof would not be guided to combine the contradicting newly presented additional materials therewith.

Next, it has not been, and is not argued that establishing a Website or transmitting audio over the Internet is new with the present invention. It is noted that the Patents to Allison and Darago et al. cited previously by the Examiner also mentioned such technology, and they are now declared moot. The new materials say nothing really new about transmitting audio over the Internet that was not already on the table via Allison and Darago et al. and so should join them as moot. That such technology exists, as established with respect to Allison and Darago et al., does not obviate every use therefore! What Applicant has argued, and is now arguing, is that the sequence of steps in the presently Pending Claims, taken as a whole, are not obviated by any reference, or reasonable combination of references. It is well established that Method Claims can protect new uses for combinations of elements, which elements were previously known in some form. In fact, that is a primary use for Method Claims where elements of a system used in the Method are known. Method Claim Patentability is found in how the elements are applied and in a previously undisclosed sequence of steps. And note---The S. Ct. in KSR states that, "As is clear from cases such as Adams, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art". In that light it is noted that the Examiner seems to be conducting the Examination by trying to show where something in the newly disclosed materials, as selected and modified by undisclosed criteria, is somehow like something in a step of the

presently Pending Claims, without looking at the sequence of steps and showing where that sequence of steps is obviated. Further, the Examiner does not show how the new materials teach away from including things disclosed therein which are not in the presently Pending Claims. This approach to Examination misses the forest (ie. the invention), for the trees, so to speak. Just because a reference discloses something which can be modified in some undisclosed way to be somehow like something in one step of a Method Claim, and another reference discloses something which can be modified in some undisclosed way to be somehow like something in another step of a Method Claim does not remotely obviate the sequence of steps or how the content of each step was established! In fact, approaching Examination by just identifying references that have somehow relevant disclosure and also irrelevant disclosure in them, but not any criteria as how to select and modify content in the identified references, while rejecting irrelevant content, demonstrates use of hindsight which is prohibited by still good law in Graham v. John Deere Co. Especially, as in the present case, where no reference discloses a sequence of steps in a Method Claim, such an approach to Examination can not be held to be a valid approach to determining Obviousness. Essentially no invention could pass such a test.

Turning now to the newly disclosed BW materials, (ie. reference "X"), it is noted that they do mention continuing legal education over Lawline.com, but focus on providing "courses" over a multi-media course delivery tool. Specifically they mention courses, bar association programs, law related public affairs programming, information for consumers about the law and advice about how to hire an attorney, and advertising opportunities. The Lawline.com materials do NOT obviate:

periodically updated audio format professional continuing education information...in topical categories...

as recited in the present Claims. Simply because the BW materials mention that audio transmitted over the Internet can have a topic concerning something somehow professionally related is not remotely enough to obviate the method of the present invention which specifically identify, in a non-obviated sequence of steps---periodically updated audio format professional continuing education information...in topical categories.... Disclosure of audio programming as described in the present Specification and Claims is simply absent in the BW materials, and nothing in the BW materials describe how to select and modify what is presented therein to arrive at what is disclosed in the presently Pending Claim Steps, while rejecting programming disclosed therein which is clearly irrelevant, to arrive at the presently Pending Claims. Simply stated, the professional topical categories disclosed in the BW materials are not what the presently Pending Claims recite! Further, the BW materials do not remotely obviate the sequence of steps in the presently Pending Claims.

Turning now to the Audible.com materials, "U" and "V" it is noted that they disclose providing audio books, and such as newspapers, magazines, journals and radio broadcasts in audio format that can be listened to according to a user's schedule. While time sensitive materials are mentioned as subject in the Audible.com materials, nothing in the Audible.com materials suggests updated professional topical categories, (see P. 10 of the recent Action where Examiner admits this), be provided or requires that the sequence of steps recited in the presently Pending Claims be practiced. It is emphasized that simply making time-sensitive audio available over the internet without more, is

not infringing of the presently Pending Claims which require practice of a sequence of steps, each of which has specific limitations, and being applied to topical categories of information. Further, the Audio.com materials do not remotely obviate the sequence of steps in the presently Pending Claims.

And, just as updated courses wherein the content is focused on overcoming identified deficiency or establishing basic education are not within the scope of the presently Pending Claims, it is important to note that even though newspapers, magazines, journals and the like might be made available on an updated basis via a website, they are not professional continuing education information available in topical categories which is prepared to keep said client aware and informed of developments in the topical category and thereby maintain professional currency therein. Such newspaper etc. periodicals provide a non-specific combination of topics which one accessing can not predict to be what is wanted thereby. The present invention professional continuing education information topical categories are specific to a well defined professional topic, (see Claim 19 for instance for examples of specific topical categories). When a client accesses a present invention topical category he or she obtains very specific information regarding a well defined specific topical professional category prepared to keep the client aware and informed of developments which are not buried in a lot of other-topic information.

Importantly, as mentioned above, the presently Pending Claims require practice of a sequence of steps, which sequence is NOT remotely obviated by any cited materials. Further, amendments entered in this Response further distinguish the presently Pending Claims, which recite:

a. an information provider ~~providing an~~ enabling internet web site accessibility;

b. said information provider producing and making periodically updated audio format professional continuing education information available from audio information format machine readable storage via said web site in topical categories, and at least impliedly agreeing to provide a service of periodically updating the content thereof a continuing multiplicity of times, wherein the content of each update is primarily focused on developments since the preceeding update, rather than on overcoming identified deficiency or establishing basic education;

(APPLICANT STRONGLY ARGUES THAT THIS STEP IS NOT OBTIATED BY ANY CITED REFERENCE OR COMBINATION OF REFERENCES)

c. making access to said audio format professional continuing education information available, via said web site to clients by a selection from the group consisting of:

periodic subscription; and

direct pay per access event;

d. said information provider allowing at least one client to receive said audio format professional continuing education information via said web site by, using an internet accessing means, accessing said web site, and providing payment via a selection from the group consisting of:

proof of paid subscription; and

presenting payment means;

and identifying a professional continuing education information topical category of interest,

followed by said at least one paying client accessing, without requirement of intermediate steps, receiving audio format professional continuing education information in said topical category of interest;

said method further comprising:

e. said information provider updating the audio format professional continuing education information in the at least one client identified topical category of interest in step d, and said at least one paying client in step d repeating step d after said audio format professional continuing education information is updated, and receiving the updated audio format professional continuing education information in said identified topical category of interest;

(APPLICANT STRONGLY ARGUES THAT THIS STEP IS NOT OBIATED BY ANY CITED REFERENCE OR COMBINATION OF REFERENCES)

said method being further characterized in that the information in said client identified and received audio format professional continuing education is prepared to keep said client aware and informed of developments in the topical category and thereby maintain professional currency therein, to the exclusion of being prepared to train said client to overcome a specific documented professional competency deficiency or to provide basic education.

(APPLICANT STRONGLY ARGUES THAT THE ABOVE OVERALL SEQUENCE OF STEPS IS NOT OBIATED BY ANY CITED REFERENCE)



Said Claim is Amended herein to require that:

b. said information provider producing and making periodically updated audio format professional continuing education information available from audio information format machine readable storage via said web site in topical categories, and at least impliedly agreeing to provide a service of periodically updating the content thereof a continuing multiplicity of times thereto,...

The reason for this is that nothing in the Audible or other cited materials disclose that providing time sensitive materials over a transmission system require a provider of the materials to at least impliedly agree with clients who pay for and access produced materials, to produce and provide access to updates of continuing professional education a multiplicity of times. This limitation is absent in all cited references. Further, the presently Pending Claims require that client actually access audio format professional continuing education information in the at least one client identified topical category of interest at least twice, with a second accessing being after said audio format professional continuing education information is updated. Nothing in any of the new materials require an agreement in any sense representing to a paying client what will be provided, or requires that any client must access anything, let alone requiring a client to access updated professional continuing education information in a topical category twice. The newly cited materials allow a client to access what is provided by such as Audible, but there is no assurance to a client that an updated version will even be made available later for a client to access again. What is provided is totally up to the programming provider who supplies the programming to Audible. In contrast, the present invention provides a client security

that an updated version will be provided by the provider of the Website, if he or she pays the provider to access it, and the presently Claimed sequence of steps requires a client at least twice access audio format professional continuing education information in the at least one client identified topical category of interest. There are no such requirements obviated by the cited materials.

OF PRIMARY IMPORTANCE IS THAT ONE SKILLED IN THE ART WOULD SIMPLY NOT, UPON A READING OF THE NEWLY CITED MATERIALS, BE MOTIVATED TO WRITE THE SEQUENCE OF STEPS IN THE PRESENTLY PENDING CLAIMS! THERE IS SIMPLY NO GUIDANCE TOWARD SUCH IN THE NEWLY CITED MATERIALS. THE OVERALL SEQUENCE OF STEPS RECITED IN THE PRESENTLY PENDING CLAIMS IS ABSOLUTELY NOT OBTAINED BY THE PRESENCE OF VARIOUS BITS AND PIECES OF VARIOUS STEPS IN MODIFIED FORMS, ALL MIXED IN WITH OTHER THINGS NOT IN THE PRESENT CLAIMS, IN THE DISCLOSURE OF THE CITED MATERIALS---WHICH PROVIDE NO INDICATION AS HOW TO PICK AND CHOOSE BETWEEN THE BITS AND PIECES THEREIN. (Again---The S. Ct. in KSR states that, "As is clear from cases such as Adams, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art". Adams was NOT overruled by the KSR decision, and in Method Claims the elements are primarily Steps interconnected by a sequence. Even if the content of steps is assumed known, (which is not the case in the present situation), a new sequence of steps is not automatically obvious unless one reference at least suggests it!

As regards Claims 1, 6, 7, 9-12, 14, 19 and 21-27 the Examiner specifically argues that Audible.com has deals with more than 80 audiobook publishers who's works it compresses and encodes for release over the internet, and has a second content area that has time sensitive information in the form of

newspapers, magazines and journals, and radio broadcasts that can be listened to according to the user's schedule. A third area involves contracts with corporations that want to communicate propriety messages through the Audible system. Also indicated as available over the Audible system are X-Files, Fresh Air, Car Talk etc. It is noted that all the identified programming is provided by other producers. Even the specifically recited Harvard Business School and instant authoring and transmission of need-to-know information and training materials are produced by other than Audible. Further, the Examiner admits on P. 10 of the recent Action that nothing in the Audible.com materials suggests updated professional topical categories be provided thereby. However, to distinguish the presently Pending Claims even more, they are Presently Amended to recite that the provider not only make available via a website, but also produce the audio format topical continuing professional education provided thereby. The Examiner identifies as "Topical Categories" (mystery, personal development, spirituality, drama/poetry, biography/history and three times a day Wall Street Journal audio editions). Again, these are not produced by Audible and are not Professional continuing education information categories as that terminology is used in the present Application, as they are not produced with a focus on maintaining professional currency in topical professional categories. Nothing in the Audible materials remotely suggest that Audible produces the materials it transmits, or that the categories should be selected with the purpose in mind to provide professionals audio format information which is focused on a specific professional area. Much like is the case in Allison and Darago et al., one is not quite sure what will be available over the Audible system when accessing it. It is believed that Audible primarily just provides a system for delivery of whatever information a user thereof pays to have distributed. The production of the audio Audible transmits is

left to those who ask Audible to transmit it. This focus of Audible is on providing of a system for transmitting materials, which is similar to what the now moot Darago et al. disclosed. Audible provides over the internet whatever it is provided to transmit by programming producers. (See PRN (W) P. 1 where it stats Audible Inc., the leader in secure delivery of Internet audio...). One interested in receiving audio updates in a topical professional category can not contact Audible and reach an agreement therewith to allow him or her to, for payment to Audible, access audio format continuing professional education programming produced and updated by Audible, as the presently Pending Claims recite.

In addition, as regards Audible, it is asked what in materials "V" remotely suggests that X-Files and Fresh Air which are identified as programming provided thereby not be provided in the presently Pending Method Claims? Without something in said Audible materials to so indicate why would one skilled in the art, and not using prohibited hindsight, not include them? Nothing in the Audible "V" materials would guide one skilled in the art to do so. The only way one skilled in the art would know to specify the programming to be audio format periodically updated continuing professional education accessible in topical categories from a website provided by the producer thereof. The only way that is determined is by use of prohibited hindsight based in having read the presently Pending Claims and the supporting Specification!

Next, even though not specifically used by the Examiner, as regards the PRN materials (W), it is specifically noted that boradcast.com provides a comprehensive selection of programming including sports, talk and music radio, television, business events, full-length CD's, news, commentary and full-length audio

books, archived press-conferences, earnings conference calls, investor conferences, trade shows, stockholder meetings, production introductions, training sessions, distant learning telecourses, and media events. This is again distinguished from what is presently Claimed as the presently Pending Claims specifically state:

"said method being further characterized in that the information in said client identified and received audio format professional continuing education is prepared to keep said client aware and informed of developments in the topical category and thereby maintain professional currency therein, to the exclusion of being prepared to train said client to overcome a specific documented professional competency deficiency or establishing basic education".

Nothing in the PRN.com material's remotely suggests that such as sports, talk and music radio, television, business events, full-length CD's, full-length audio books, archived press-conferences, earnings conference calls, investor conferences, trade shows, stockholder meetings, production introductions, training sessions, distant learning telecourses, and media events should be deleted, but they are not professional continuing education provided by the present invention. How would one skilled in the art then know to so delete said categories. Further, and importantly, the PRN (W) materials make clear that Audible is a provider of a SYSTEM for transmitting programming, not producing programming. "See P. 1, where it states "Audible Inc., the leader in secure delivery of Internet audio for mobile playback, today announced a joint marketing agreement. The alliance includes Audible's long term advertising commitment for the Audible MobileAudio(tm) System on boradcast.com, and broadcast.com's future plans to mobilize

selected audio programming from its Web sites". As described above, the present method differs as a client, (in the present invention sense), does not approach Audible and reach an at least implied agreement to receive, via the internet and in return for paying a fee, a continuing multiplicity of audio format professional continuing education updates prepared thereby to keep said client aware and informed of developments in the topical category and thereby maintain professional currency therein, to the exclusion of being prepared to train said client to overcome a specific documented professional competency deficiency or establishing basic education. Audible is seen to by very much a provider of a system which can be used by any source of programming as a transmission via, as was the case regarding the Darago et al. Patent which primarily disclosed a system.

Audible does not even impliedly agree with a client, in the present invention sense, to do anything,

let alone provide programming as described in the presently Pending Claims. Rather,

Audible agrees with sources of programming to transmit what is provided to Audible from those sources.

The Sabludawsky (UU) materials describe something a bit different from the Audible and BW materials, but it is noted that they disclose a company "Examco" which produces "courses" meant to prepare those who access their programming for exams. This is reminiscent of the now moot Allison Patent, and is distinguished from what is presently Claimed because the presently Pending Claims specifically state:

"said method being further characterized in that the information in said client identified and received audio format professional continuing education is prepared to keep said client aware and informed of developments in the topical category and thereby maintain professional currency therein, to the exclusion of being prepared to train said client to overcome a specific documented professional competency deficiency or establishing basic education".

A similar distinction is valid as regards the Boyers (VV) materials, which do not identify distribution over the Internet. Said materials describe, for instance, distribution over private, (eg. telephone connections), networks and by CD's. Where the words "on-line" are mentioned in said materials, (see P. 5), the terminology "private network" is also recited and the focus is disclosed as being the providing of testing for which results can be immediately obtained. The materials proceed to mention courses were being made available. This is very much like what the Allison Patent described. Boyers (VV) is again distinguished from what is presently Claimed as the presently Pending Claims specifically state:

"said method being further characterized in that the information in said client identified and received audio format professional continuing education is prepared to keep said client aware and informed of developments in the topical category and thereby maintain professional currency therein, to the exclusion of being prepared to train said client to overcome a specific documented professional competency deficiency or establishing basic education".

As regards the Rosenblum (WW) materials, they simply disclose that Audible.com and Audio Highway were up and running.

The programming identified is disclosed as a mix of spoken audiobooks, magazines and radio-shows for the morning commute. Music is also attributed to Audio Highway and Audible.com is further described as providing Car Talk, Garrison Keillor's Prairie Home Companion, business newsletters and the Economist magazine. This is again distinguished from what is presently Claimed as the presently Pending Claims specifically state:

"said method being further characterized in that the information in said client identified and received audio format professional continuing education is prepared to keep said client aware and informed of developments in the topical category and thereby maintain professional currency therein, to the exclusion of being prepared to train said client to overcome a specific documented professional competency deficiency or establishing basic education".

DISCUSSION IMPORTED FROM THE PREVIOUS  
RESPONSE TO OFFICE ACTION IN PART

Finally, as discussed in the previous Response to Office Action, which is incorporated hereinto in its entirety by reference, do note that Claim 19 specifically recites:

patent, trademark, copyright, trade secret, computer, internet, unfair competition, high-tech, contract, tort, property, wills & trusts, criminal, evidence, constitutional, corporate, taxation, estate planning, securities, banking, bankruptcy, accounting, trade regulation, commodities, insurance, energy, environment and water, aviation, automobile, labor, social security, family, divorce, juvenile, workman's compensation, personal injury, product liability, employment practices, administrative, educational,



mass communications, medical, farm, and military;

science, medical and technology related areas of:

astronomy, architecture, mathematics/statistics, physics, chemistry, engineering (electrical/electronic, nuclear, mechanical, civil, chemical, biological, genomic, construction, transportation, industrial, manufacturing, agricultural, computer, energy, environmental), horticulture/forestry, geology, food science, nutrition, psychology, zoology, veterinary, medicine (anatomy, physiology, bio-chemistry, cardiology, renal, gastro-intestinal, pulmonary, pathology, microbiology), pharmacy, nursing, Scientology/Dianetics;

as do Presently Pending Claims 11, 12.

It is also noted that Claim 19, step f requires an additional Limitation, that being a reaccessing of previously accessed information a second time, is amended to read:

f. said client, after step e, again accessing the audio format professional continuing education information originally provided in a practice of step d before the information is being updated and accessed in step e, by again practicing step d with the addition that the identifying date with which said updated audio format professional continuing education information was tagged is entered along with the identifying of a professional continuing education information topical category of interest;

The Examiner's arm waving position, that it would be obvious to update information to courseware current in order to sustain

business operations, does NOT explain why one would then access old information again as required in Claim 19. There would be no reason to access old courseware if new courseware replaced it! In combination with other non-obviated steps and content of Claims which recite time-tagging, it is believed that limitation absolutely distinguishes the present invention over all cited references.

Further, the Examiner notes that "Time Stamps" are known. However, knowing about the existence of Time Stamps is very different from the Method step application thereof in the Present Invention Claim 19. It is noted that the existence of an element of an invention in a vacuum, without instructions as how to apply it in other than the Present Specification, can not obviate use thereof in a New Invention Method. Method Claims often Claim New Uses for existing elements. As in the Darago et al. 014 case, additional identification of the application of Time Stamps is simply different from that in the Present Invention Claims, in the context of said presently Pending Claims. Hence such references teach away from the Present Invention useage thereof.

Further, in view of the foregoing, it is argued that nothing in any cited reference suggests the sequence of steps recited in the Present Claims herein. The Lawcast materials come the closest, but teach away from use of computers, hence the Internet, for distribution. And, even if the Lawcast materials were a proper obviating reference, (which they are not!), they do not describe the sequence of steps in the Claims Pending herein, and especially Claim 19. And, as disclosed above, Lawcast has only relatively recently, (about a year ago), begun to consider distribution via the internet. The present Application priority however, predates that by many years. Previous disclosure by

Lawcast taught away from use of the Internet. Lawcast leaves one with the mind-set that, as Jason Meyers says "Even computers - no matter how good they get, you can't use them in the car, said Meyer. "You can't use them as you walk".

For emphasis, as regards Claims 17, 18, 19 and 20, which recite "Time/Topic Tags", it is again argued that existence of the element of "tagging" in prior art settings does not lead one skilled in the art in the Present Scenario Claims to necessarily think of it, along with all the other Limitations in the Present Claims. Nothing in any cited reference remotely suggests, as is recited in, for example, Present Claim 19:

f. said client, after step e, again accessing the audio format professional continuing education information originally provided in a practice of step d before the information is being updated and accessed in step e, by again practicing step d with the addition that the identifying date with which said updated audio format professional continuing education information was tagged is entered along with the identifying of a professional continuing education information topical category of interest;

said method being further characterized in that the information in said client identified and received audio format professional continuing education is prepared to keep said client aware and informed of developments in the topical category and thereby maintain professional currency therein, to the exclusion of being prepared to train said client to overcome a specific documented professional competency deficiency or establishing basic education.

As stated above, the presently Pending Claims herein provide

a Method sequence of Method steps which are not remotely obviated by any cited reference. One skilled in the art who reads said cited materials simply would not automatically arrive at the Steps of the Present Invention Claims. One could, after reading said materials envision any number of imaginative sequences of steps which are not suggested thereby, and offer no instructions as how to eliminate them. The presently Pending Claims therefore identify novel methodology.

Futher, that Katz 5,926,624 discloses making permanenet records does not obviate use made of that in the present invention.

#### REGARDING CASE LAW

It noted that the Examiner cites the KSR case, which concerned System/Apparatus Claims, not Method Claims, as authority. As discussed in my Response to the previous Action by the Examiner, the KSR case did NOT overrule the time tested criteria recited in Graham v. John Deere Co. and other cases, and the KSR case was based on absolutely damning facts which justify the recitation therein. In KSR a Patent which was not before the Examiner during the examination procedure, regarding an adjustable pedal System/Apparatus, completely obviated a Claim in an Issued Patent, (6,237,565,) to an adjustable pedal. Had the Patent which was not before the Examiner during the examination procedure been before the Examiner as it was before the S.CT., it was clear from the prosecution history of the 565 Patent that said Claim would have been rejected as were other Claims in the application in a similar manner. The language the Examiner recites from the KSR case must be interpreted in view of the setting in which it was written. In KSR it was blatantly true that the Patent which was not before the Examiner during Examination did disclose what the system Claim on point in the case. FURTHER, IT IS NOTED THAT THE KSR CASE DID NOT SPEAK TO METHOD CLAIMS, HENCE USE OF ITS LANGUAGE AS AN AUTHORITY IN THE

PRESENT EXAMINATION OF METHOD CLAIMS IS NOT VALID! AS REGARDS  
METHOD CLAIMS, THE LAW HAS NOT BEEN SUBSTANTIALLY CHANGED BY KSR  
AND THE EXAMINER MUST APPLY PRINCIPALS IN EXISTING LAW THAT WERE  
NOT EVEN REMOTELY OVER-RULED BY KSR. WITHOUT SOME DIRECT  
GUIDANCE IN KSR AS TO HOW ITS LANGUAGE SHOULD BE APPLIED TO  
METHOD CLAIMS, IT IS SIMPLY NOT GOOD LAW AS REGARDS METHOD  
CLAIMS. GUIDANCE IN KSR IS FOCSED ON A SYSTEM/APPARATUS CLAIM,  
AND TO BE VERY BLUNT---(COMMENTARY---IT LOOKS TO ME THAT KSR WAS  
A TRUMPED-UP CASE MEANT TO FURTHER THE DEMISE OF THE PATENT  
SYSTEM, ALONG WITH THE SANDISK ETC. CASES, (AND THE NOW ENJOINED  
NEW CONTINUATION RULES AND THE PROPOSED NEW APPEAL RULES ETC.  
ETC.)---ALL OF WHICH CASES DEPENDED ON UNBELIEVABLY ABSOLUTELY  
DAMNING FACT SCENATIOS. I ACTUALLY AGREE WITH THE DECISIONS IN  
THE KSR AND SANDISK CASES BASED ON SPECIFIC CASE FACTS BEFORE THE  
COURT THAT DECIDED THEM, BUT I CONDEMN TRYING TO EXTEND SUCH  
NONSENSE IN A GENERAL SENSE. PATENT LAW HAS DEVELOPED OVER A  
LONG PERIOD OF DECADES IN A MANNER BASED ON MOSTLY COMPETENT  
DECISIONS BY COURTS FOR GOOD REASONS. A SMALL NUMBER OF RECENT  
CASES BASED ON ABSOLUTELY UNBELIEVABLY DAMNING FACT SCENARIOS CAN  
NOT BE ALLOWED TO COMPLETELY OVERTURN SUCH! AGAIN IN PARTICULAR,  
KSR DID NOT GIVE ANY GUIDANCE WHAT-SO-EVER AS HOW TO APPLY WHAT  
IT SAYS TO METHOD CLAIMS! METHOD CLAIMS WERE NOT BEORE THE S.CT.  
IN KSR. I THINK WHAT IT AND SANDISK ETC. SAY MUST, AND WILL IN  
FUTURE DECISIONS WHEN SANE CONSIDERATION IS PROVIDED TO THEM, BE  
LIMITED TO THEIR FACT SCENARIOS WHEN ALL IS SAID AND DONE.  
FURTHER, THE EBAY CASE, WHICH DENIED INJUNCTION PROTECTION TO A  
PATENT HOLDER---THERE THE ACTUAL RESULT WAS THAT THE CASE JUST  
SENT BACK DOWN TO BE RE-REASONED IN VIEW OF STATED FACTORS, WHICH  
WOULD STILL ALLOW PRE-EXISTING PRACTICE TO CONTINUE, AND WHICH  
WILL CONTINUE AFTER ALL IS SAID AND DONE).

Continuing, it is emphasised that Graham vs. John Deere  
Co., which is still good law, requires that a finding of

obviousness under Section 103 must be based on a primary reference which, while not completely disclosing an entire new invention, (via Section 102), provides guidance to one skilled in the art that would lead him or her to seek out additional art, and incorporate said additional art into the primary reference in a way that results in the new invention. There must be teachings in the primary reference that would direct one skilled in the art to select elements in identified additional art, (while rejecting other elements therein), then modify said selected elements and combine them with elements in the primary reference to arrive at the new invention. It is argued that a proper application of Graham must also suggest elimination of elements in the primary reference which are not a part of the new invention, and if certain elements in a primary reference can not be eliminated while leaving the invention therein operable, then it must be concluded that nothing in the primary reference suggests their elimination. A new invention that does not include such necessary elements in a primary reference invention can not be found obvious based on the primary reference, if said necessary element can not be eliminated in the primary reference without rendering it inoperable.

Again, for emphasis---the Examiner cites the KSR case, but it is emphasised that the KSR decision did not overrule prior law, was based on absolutely damning facts, was focused on System/ Apparatus Claims and is lacking in direction as to how its language applies to Method Claims. The best analysis I can offer is that if KSR is to be applied to Method Claims, based on how it was applied to System/Apparatus Claims, there would by necessity have to be a reference that provided, in order and but for minor differences, the sequence of steps of the Method Claim being considered. That is how close was the prior art System/Apparatus in the Patent which was not before the Examiner

during examination was recited in the System/Apparatus Claim under consideration by the S. Ct. in KSR. The S. Ct. did have the missing Patent before it, and based on its disclosure saw that had the Examiner known of it the Claim under contest would not have Issued. When I read the KSR case I agree with the decision based upon the facts involved, but I do not remotely think it should be given credibility beyond the facts scenario upon which that decision was based! And it definitely can not be blindly applied to Method Claims, to which it did not speak!

Again, the S. Ct. did NOT over rule the time tested prohibition on the use of Hindsight in Patent Examination. The S. Ct. even states in its opinion:

In Graham v. John Deere Co. of Kansas City, 383 U.S. 1 (1966), the Court set out a framework for applying the statutory language of Section 103, language itself based on the logic of the earlier case Hotchkiss v. Greenwood, 11 How. 248 (1851), and its progeny. See U.S., at 15-17. The analysis is objective:

"Under Section 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc. might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." Id, at 17-18.

While the sequence of these questions might be reordered in any particular case, the factors continue to define the

inquiry that controls. If a court, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid under Section 103.

It is still the law that a Patent Examiner can not conduct an obviousness analysis by reading an Application, identifying elements of the invention therein and then using said hindsight simply seeking out a plurality of references that contain elements which are somehow like those in the invention on point, and then without some single reference, (other than the Application before him or her), providing teachings as how to identify said elements in the prior references, modify said elements selected therefrom and combine them as the Application directs to arrive at the invention being examined, while also providing teachings as to why other elements in said plurality of references should not be selected. If no single reference, other than the Application before the Examiner provides said teaching, then the Examiner can not properly find obviousness. This remains the law. The question as to what one skilled in the relevant art would be aware, of course is relevant. And the KSR case teaches nothing more than if the invention concerns Adjustable Pedals, then one skilled in the art should be aware of Patents that have those exact words in their titles. That is all KSR teaches! The S. Ct. in KSR holds that "Rigid preventive rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it." This is not an objectionable position in view of the facts of the KSR case.

The KSR case also leaves in place as good law, the principal from United States v. Adams, 383 U.S. 39, 40 (1966) which holds that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining then is



more likely to be nonobvious. ID, at 51-52. The S. Ct. in KSR states that, "As is clear from cases such as Adams, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art".

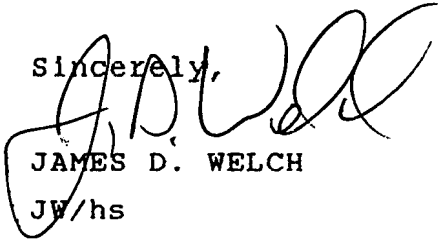
As regards the Dependent Claims, the above is generally identified as serving to make the Independent Claims Allowable, and therefore the the Dependent Claims are Allowable as depending from Allowable Claims.

In summary, it is argued that one skilled in the art would not remotely write the presently Pending Claims having studied the newly cited materials, if asked to describe what said newly cited materials disclose. This is because said materials, either alone or even in combination with previously cited materials, while providing a lot of untoward disclosure which is not incorporated in the presently Pending Claims, does not give any insight as to why the present invention does not include such but does include other disclosed elements which if modified by instruction which are not present in said cited materials, are arguably somehow like included elements. That the Examiner can see that the sequence of steps in the presently pending Claims provides a workable Method is very different than properly arriving at a conclusion of Obviousness based on existing materials, as opposed to based on application of prohibited hindsight! The Examiner can not just assume the present invention Claim Sequence of Steps exists without identifying some reference, other than Applicant's Specification and Office Action Responses, as obviating thereof. Allowing assumptions of that sweeping a magnitude would enable arbitrary rejection of any Claim in any Application, which is clearly, even in view of recent Patent diminishing developments in Patent Case Law, and

proposed Rule changes, (of which the Continuation Rules were appropriately enjoined), still not at all the purpose and intent of the Patent Examination process and the Patent System.

It is believed, that in view of the Discussion and/or the attached Attestation, that Claims 1 - 27, as Amended, are now Allowable. Therefore the Examiner is respectfully requested to provide the Notice of Allowance and Issue Fee Due. Should problems remain, Applicant welcomes suggestion from the Examiner.

Sincerely,



JAMES D. WELCH

JW/hs

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**Claim Rejections - 35 USC § 103**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. *Indep 1; 12, 19, 23*

- 1. Claims 1, 6, 7, 9-12, 14, 19 and 21-27 are rejected under 35 USC 103(a) as being unpatentable over Audible.com (a collection of prior art documenting Audible, Inc. business methods cited in PTO-892, Items: U pages 1-3, and V pages 1-11) in view of BW (PTO-892, Item: X, pages 1-2) further in view of Lawcast (Paper #20070102, PTO-892, Item: V, pages 1-2).**

Audible.com teaches Audible, Inc., the Wayne, N.J.-based company is revolutionizing the distribution of content by enabling users for a fee to download material from its World Wide Web site that they can play back with the portable Audible player. Audible.com teaches Audible, Inc. having three main sources of revenue streams. To support its first revenue stream, the delivery of audiobooks over the Internet, Audible has deals with more than 80 audiobook publishers whose works it compresses and encodes for release over the Internet at the same time the books hit the retail shelves. The second content area (i.e. revenue stream) has time-sensitive information that may or may not have existed previously in audio form. It is this category, audio versions of newspapers, magazines, and journals, and radio broadcasts that can be listened to according to the user's schedule. The third portion of Audible's business is contracts with corporations that want to communicate proprietary messages through the Audible system. Audible will encode the corporation's audio content and secure it

ATTACHMENT "A"

## Notice of References Cited

Application/Control No.

10/796,162

Applicant(s)/Patent Under  
Reexamination  
WELCH, JAMES D.

Examiner

Robert M. Pond

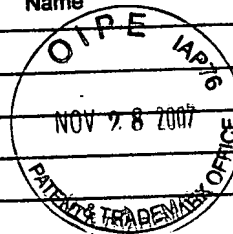
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3625

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## U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-5,926,624	07-1999	Katz et al.	709/217
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			



## FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
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	O					
	P					
	Q					
	R					
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	T					

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	V	Audible.com: Internet Wayback Machine, www.archive.org; www.audible.com; 18 January 1998; 12pgs. <i>? not Lawcart</i>
	W	PRN; "Broadcast.com and Audible announce partnership," PR Newswire, 17 August 1998, Proquest #33162901, 3pgs.
	X	BW: "Lawline.com offering continuing legal education," Business Wire, 26 May 1999, Proquest #41887583, 2pgs.

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

# ATTACHMENT "A"

## Notice of References Cited

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B	US-			
C	US-			
D	US-			
E	US-			
F	US-			
G	US-			
H	US-			
I	US-			
J	US-			
K	US-			
L	US-			
M	US-			

### FOREIGN PATENT DOCUMENTS

* N	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
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P					
Q					
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S					
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V	VV: Boyers, Karla; "Reach out and touch someone," Association Management, June 1996, v48i6pg41, Proquest #9720477, 9pgs.
W	WW: Rosenblum, Trudi; "Downloading audio from the Internet:the future of audio?" Publishers Weekly, 02 March 1998, v245i9pg27, Proquest #27035250, 4pgs.
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In MM-YYYY format are publication dates. Classifications may be US or foreign.